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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/075,791  | 02/12/2002  | Freddie W. Smith     | MI40-340              | 1066             |
| 21567   | 7590        | 09/20/2005           | EXAMINER              |                  |
| WELLS ST. JOHN P.S.<br>601 W. FIRST AVENUE, SUITE 1300<br>SPOKANE, WA 99201 |             |                      | HOLLOWAY III, EDWIN C |                  |
|   |             | ART UNIT             | PAPER NUMBER          |                  |
|   |             | 2635                 |                       |                  |
| DATE MAILED: 09/20/2005   |             |                      |                       |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                   |
|------------------------------|------------------------|-------------------|
| <b>Office Action Summary</b> | Application No.        | Applicant(s)      |
|                              | 10/075,791             | SMITH, FREDDIE W. |
|                              | Examiner               | Art Unit          |
|                              | Edwin C. Holloway, III | 2635              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 March 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 64-95 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 64-95 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

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***EXAMINER'S RESPONSE***

1. In response to applicant's preliminary amendment filed 3-4-04, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Specification***

2. The disclosure is objected to because of the following informalities: The paragraph with reference to the prior application 09/020585 inserted as the first sentences of the specification of this application should be replaced with an updated paragraph including the current status of all nonprovisional parent applications referenced, including Patent No. 6356535. A reference to SN 09449031 and PN 6717923 may also be appropriate.

Appropriate correction is required.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 64-76, 86-88 and 95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6356535 and/or claims 1-25 of U.S. Patent No. 6717923. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the claims in the instant application would have been obvious in view of the limitations of the claims in the '535 and/or '923 patent interpreted in light of the specification. Although a restriction was made in the '535 patent, a double patenting rejection is now proper because at least claims 64 and 70 of the instant application are linking claims directed to system and communication device/apparatus limitations that would have precluded a proper restriction if present in the parent application(s). In particular, all the limitations except the interrogator, communication circuitry and beam steering in claim 64 are provided in claim 13 of the '923 patent and the missing

limitations would have been obvious in view of dependent claims 17, 19 and 20 respectively of the '923 patent. The transponder limitation suggests an interrogator. All the limitation of claim 70 are included in claim 1 of the '535 patent, except for the backscatter limitation that is in dependent claim 9 of the '535 patent. Further, the interrogator of claim 1 in the '535 patent is suggested by claim 70 of the instant application receiving signals from an interrogator. Method claim 86 is generally broader than method claims 12-31 of the '535 patent and claim 25 of the '923 patent. Outputting an interrogation signal is at least suggested by the receiving of the interrogation signal in the patented claims. The limitations of claim 95 is included in claims 13-24 of the '923 patent with the exception of the substrate that is suggested by the use of integrated circuits. The dependent claim limitations would have been obvious in view of the dependent claim limitation in the patent(s).

5. Claims 69, 77-85 and 89-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6356535 and/or claims 1-25 of U.S. Patent No. 6717923 as applied above and further in view of Works (US 3745569) or Heinrich (US 5606323). Works and Heinrich discloses transponders with

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dipoles on substrates and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included such in the invention claimed in applicants prior patent(s) to provide low cost, small size transponders.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heinrich (US 56606323) discloses an RF transponder with dipole antenna shorted by modulator. Korvin (US 3569976), Williams (US 4173019), Polzer (US 4630044), Meunier (US 5081458), Haruyama (US 5119099), Nysen (US 5164985), Minesi (US 5889478) and Palmer (US 5942977) disclose RF devices, systems and methods cited by the examiner in US 6717923.

***CONTACT INFORMATION***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

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Prior to July 15, 2005, facsimile submissions may be sent via central fax number (703) 872-9306 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

**CENTRALIZED DELIVERY POLICY:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH  
9/19/05

*Ed C. Holloway*  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635